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Supervisory Patent Examiner Andrew Fischer
P/3621
TC 3600 - GROUP ART UNIT 3621

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Dear Examiner Fischer,

Thank you for offering to review Application No. 09/923,704 (Title: "Information Management System," Examiner: Pierre Elisca). In order to assist in your review, Applicant submits this memo outlining Applicant's concerns. Please do not hesitate to contact the undersigned with any comments or questions.

Brief History of the Application's Prosecution

Applicant filed a Pre-Appeal Brief Request for Review on November 23, 2005 alleging that there was clear error in the rejections of the claims under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,853,726 issued to Shwed et al. ("Shwed"). A Notice of Panel Decision from the Pre-Appeal Brief Review of March 1, 2006 indicated an allowable application. The Examiner issued an Ex Parte Quayle Action on May 19, 2006 indicating allowable claims and requiring amendments to address formal matters. Applicant filed a response to the Ex Parte Quayle action making the required amendments. The Examiner then issued the Office Action of October 20, 2006 ("the Previous Action") rejecting the claims under 35 U.S.C. § 103 as being obvious in view of Shwed (previously cited) and U.S. Patent Application Publication US 2003/0140282 A1 ("Kaler"). After telephone interviews on November 8, 2006 and January 22, 2007, the Examiner agreed to issue a new Office Action to address inadequacies of the Previous Action. Accordingly, the Examiner issued the Office Action of February 9, 2007 ("the Current Action").

**The Current Office Action Essentially Repeats the
Rejections That Were Overcome by the Pre-Appeal Brief Conference
and Does not Meet the Requirements of 37 CFR § 1.104(c) or 35 U.S.C § 132**

Applicant notes that Primary Examiners are allowed to reject claims that have been indicated to be allowable. However, MPEP §706.04 states that “[g]reat care should be exercised in authorizing such a rejection.” As such, upon learning of the new rejections, Applicant expected the rejections to be different from the rejections that had been overcome by the Pre-Appeal Conference. Instead, the new rejections are practically identical to the already overcome rejections. Furthermore, the new rejections are without merit; do not clearly explain the pertinence of the new reference (Kaler) as required by 37 CFR § 1.104(c); and do not make out a prima facie case of obviousness as required by 35 U.S.C. § 132.

I. The Current Rejection of Claim One is Practically Identical to the Rejection that was Overcome by the Pre-Appeal Brief Conference

Claim 1 is listed below. The portion in bold is the portion with an updated rejection using Kaler. The remainder of the claim is rejected, as it was before the Pre-Appeal Conference, in view of Shwed.

An information management system comprising:
a plurality of workstations adapted for connection to a computer network, each workstation having a memory;
a data repository arranged to receive data from each of said workstations;
an application stored in said memory of each workstation for transmitting outbound data to said computer network and receiving inbound data from said computer network;
policy data containing rules defining relevant commercial data which is to be stored in said data repository; and
an analyser, said analyser being operable in conjunction with said policy data to monitor at least one of said outbound data and said inbound data, to identify in at least one of said outbound data and said inbound data, relevant commercial data that is to be stored in said data repository in accordance with said rules in said policy data, and to cause said relevant commercial data to be stored in said data repository. ~ policy

In contrast to claim 1, Kaler describes systems and methods for analyzing the performance of a data processing system. In Kaler, “[i]nformation about the flow and performance of [an] application can be specified, captured, and analyzed, without modifying it or degrading its performance or data security characteristics” (Kaler, Abstract). Kaler also notes that

[t]he invention is commercially available from Microsoft Corporation as the 'Visual Studio'® development system or 'Visual Studio Analyzer'®. In addition, certain portions of the invention are provided within the Microsoft Windows ® operating system (Kaler, Paragraph 96).

Visual Studio is a software development product and Visual Studio Analyzer is a performance analysis tool. Neither are concerned with analyzing commercial data in inbound and outbound network traffic or related to policy data.

In explaining the rejection of claim 1, the Examiner stated that Shwed "fails to explicitly disclose that an analyzer, said analyzer being operable in conjunction with said policy data." (Current Action, page 4, emphasis added). The Examiner then stated that "Kater (sic) discloses a method/apparatus for analyzing the performance of a data processing system, particularly a distributed data processing system, provide a system user with tools for analyzing and application running thereon" (Current Action, page 4).

The Examiner's comments provide no indication of what in Kaler shows or suggests anything "operable in conjunction with said policy data." Instead, the Examiner seems to have merely updated the already overcome rejection by adding a reference that is totally unrelated to claim 1 and, in contrast to claim 1, merely relates to tools for analyzing the performance of an application. Applicant has reviewed Kaler in an attempt to determine what the Examiner believes to show or suggest an "analyzer being operable in conjunction with said policy data." However, nothing in Kaler shows or suggests any such thing.

The Examiner's suggested motivation to combine provides no clarification of what the Examiner believes to show or suggest "said analyzer being operable in conjunction with said policy data." The Examiner states that "it would have been obvious ... to modify the teaching of Schwed by including the limitation detailed above as taught by Kater (sic) because this would analyze performance of a data processing syste (sic)" (Current Action, page 4). The motivation provided by the Examiner appears to agree with the Applicant's assertion that Kaler merely discusses tools for analyzing the performance of an application and is totally unrelated to claim 1.

Accordingly, Applicant respectfully asserts that the Examiner has essentially ignored the decision of the Pre-Appeal Brief Conference Panel by making a superficial alteration of the

rejection of claim 1 and then repeating the rejection. Applicant respectfully submits that this is inappropriate and requests the withdrawal of the rejection.

II. The Rational Used in Rejecting Various of the Independent Claims in the Current Action is Without Merit and Offers No Improvement Over the Rational of the Rejections of these Claims in Office Actions issued before the Pre-Appeal

As noted in the Pre-Appeal Brief, the Office Actions issued before the Pre-Appeal Brief did not include an indication of what the Examiner believed to show or suggest various elements of independent claims 114, 136, and 476; 178, 220, and 498; 304, 329, and 540; 377, 398, and 565. The Previous Action (i.e. the Office Action issued after the Pre-Appeal Brief) also lacked any of these indications. For example, independent claim 114 recites

policy data containing rules specifying an appropriate encryption strength for outbound data, the encryption strength depending on the content of the data; and

an analyser, said analyser being operable in conjunction with said policy data to monitor said outbound data and to determine, in accordance with said rules in said policy data, an appropriate encryption strength for the outbound data; wherein said analyser controls transmission of said outbound data from said application in dependence upon said determination of an appropriate encryption strength.

No indication of what the Examiner believes to show or suggest any of the underlined portions of claim 114 was made in the Previous Action. The undersigned discussed this with the Examiner during the two phone interviews and the Examiner issued the Current Action to correct this deficiency.

Instead of improving the Previous Action, the Current Action merely notes that Shwed shows or suggests "encryption of outbound packets." The Examiner then alleges that the mere presence of encryption shows or suggests "appropriate encryption strength" (Current Action, page 6, emphasis added). Furthermore, the Examiner provides no indication of what shows or suggests, for example, "specifying an appropriate encryption strength," "encryption strength depending on the content of the data," or "an appropriate encryption strength for the outbound data; wherein said analyser controls transmission of said outbound data from said application in dependence upon said determination of an appropriate encryption strength" as independent claim 114 requires.

The Examiner used the same rational in rejecting independent claims 136, 377, 398, 476, and 565. No updated rejections were provided for independent claims 178, 220, and 498; or 304, 329, and 540.

Conclusion


Applicant believes the Application to be in condition for allowance and respectfully requests the withdrawal of the rejections to the pending claims.

Please do not hesitate to contact the undersigned at (212) 937-7274 with any questions or comments. Otherwise, as you suggested, the undersigned will call you this Friday, March 2, 2007.

Thank your for agreeing to review this application,

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